

d) REMARKS

The claims are 83-88, 90, 91, 95, 97-104, 109-112, 114, 116-126, 128, 129, 133 and 135-145 with claims 83 and 121 being independent. Claims 113 and 115 were cancelled and their subject matter added to claims 83 and 121. Reconsideration of the claims is respectfully requested.

The status of the parent case has been updated, as requested.

References JP-B 36-10231 and JP-B 56-13945 stricken by the Examiner in the previously submitted Form PTO-1449 are not material and, accordingly, no further action has been taken to make them formally of record. For the record, a copy of JP-B 36-10231 and JP-B 56-13945 has been provided.

An information submission has been provided for EP 0712048 and EP 0933685, which were cited, but not previously considered. A copy of the EP references, a Search Report citing them and a check for \$180.00 for submission of such information has been provided.

Claims 83-88, 90, 91, 95, 97-104, 112, 117-126, 128, 129, 133 and 135-145 were rejected as anticipated by Nagase '681. Claims 83-88, 90, 91, 95, 97-104, 109-111, 113, 117-126, 128, 129, 133 and 135-145 were rejected as anticipated by Chigono '456. Without necessarily agreeing or disagreeing and solely to expedite prosecution, independent claims 83 and 121 have been amended to include the subject matter of claims 113 and 115. Since claim 115 was not rejected as anticipated by Nagase '681 or Chigono '456, it is submitted that the anticipation rejection has been obviated and should be withdrawn.

Claims 115 and 116 were rejected as obvious over Chigono '456 in view of Itami '409. Itami '409 was cited for a contact angle of at least 90°. Claim 114 was rejected as obvious over Chigono '456 in view of U.S. Publication 2002/0048711. Since both independent claims include the subject matter of claim 115, the rejection of claim 114 has been rendered moot. The remaining ground of rejection is respectfully traversed.

Applicants will demonstrate that it would not have been obvious to prepare the Chigono image-bearing member with the Itami contact angle of at least 90°.

As noted on specification page 161, the image-bearing member has a surfacemost layer with a volume resistivity of  $1 \times 10^9$  -  $1 \times 10^{14}$  ohm.cm. Within this range, better charge transfer and electrostatic image retentivity are provided even at high humidity and at high processing speeds. As noted on page 166, the image-bearing member has a surface contact angle with water of at least 85 degrees. This facilitates release of toner particles to reduce residual particles and to suppress chargeability reduction.

The importance of volume resistivity and surface contact angle are demonstrated by comparing the results of inventive Photosensitive Member 1 (page 192) having a volume resistivity of  $5 \times 10^{12}$  ohm.cm and a contact angle with water of 102 degrees with reference Photosensitive members 2-4 disclosed on pages 192-194.

Photosensitive member 2 has a contact angle with water of only 78 degrees, which value is below the 85° claimed minimum; Photosensitive member 3 has a volume resistivity of only  $2 \times 10^7$  ohm.cm, which is below the  $10^9$  ohm.cm minimum, while Photosensitive member 4 has a volume resistivity of  $1 \times 10^{15}$  ohm.cm (above the  $10^{14}$  ohm.cm maximum) and a contact angle of only 73 degrees.

In Table 6, on page 255, performance results are provided employing Photosensitive Members 1-4 for Examples 23-26. A discussion of the results with Photosensitive member 1 as compared to Photosensitive members 2-4 is found on pages 228-232 and pages 236-237. A discussion of the corresponding values to the A, B, C and D values in Table 6 is found on pages 232-236.

When comparing the results of Example 23 with Examples 24-26, it is evident that where the contact angle is below 85 degrees as in Examples 24 and 26, i.e., 78° and 73°, that transferability and chargeability are significantly reduced and fog formation is significantly increased. Where the contact angle is above 85° as in Example 25, but volume resistivity is below  $10^9$  ohm.cm, fogging is exacerbated.

The comparative test results clearly demonstrate the importance of the contact angle of the image-bearing member and are unexpected. The showings rebut any possible presumption of obviousness.

Wherefore, it is requested that the claims be allowed and the case passed to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Saxon", written over a horizontal line.

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